

REMARKS/ARGUMENTS**I. General**

Claims 1-77 were pending in the application. In the Final Office Action (mailed March 20, 2003), claims 1-20, 22-70, and 72-77 are rejected and claims 21 and 71 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The outstanding issues in the present Office Action are:

- Claims 1-10, 12-19, 22-38, 40-59, 61-69, and 72-77 are rejected under 35 U.S.C. § 102(e) as being anticipated by Published U.S. Patent Application Number 2002/0026452 A1 of Baumgarten et al. (hereinafter “*Baumgarten*”); and
- Claims 11, 20, 39, 60, and 70 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Baumgarten* in view of U.S. Patent Number 6,266,659 issued to Nadkarni (hereinafter “*Nadkarni*”).

In response, Applicant respectfully traverses the outstanding claim rejections, and requests reconsideration and withdrawal thereof in light of the remarks presented herein.

II. Claim Rejections Under 35 U.S.C. § 102(e) over *Baumgarten*

Claims 1-10, 12-19, 22-38, 40-59, 61-69, and 72-77 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Baumgarten*. Applicant respectfully reasserts the arguments presented in Applicant’s first Amendment (mailed January 28, 2003), and requests that the Examiner reconsider the arguments presented therein. For conciseness, Applicant further addresses the Examiner’s response to Applicant’s arguments herein below.

A. Relied Upon Portion of *Baumgarten* is not Prior Art Under 35 U.S.C. § 102(e)

The present application has a filing date of August 17, 2000. *Baumgarten* is a published U.S. patent application having a filing date of May 17, 2001, and claims the benefit of a provisional patent application having a filing date of May 17, 2000. The Examiner uses the date of the provisional patent application as the § 102(e) date of *Baumgarten*, which seems consistent with the *Examination Guidelines for 35 U.S.C. § 102(e), as amended by the*

American Inventors Protection Act of 1999, and further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002, and 35 U.S.C. § 102(g) (see e.g., Section IV “Examination Procedures under 35 U.S.C. §§ 102(e) and 374” thereof).

However, Applicant respectfully submits that only the subject matter that was actually present in the provisional patent application (referred to hereafter as “*Baumgarten Provisional*”) is afforded the earlier date of May 17, 2000. For instance, the published U.S. patent application of *Baumgarten* having a filing date of May 17, 2001 appears to have matter included therein that was not present in *Baumgarten Provisional* (such as FIGURES 2-5 and corresponding descriptions thereof), and such new matter is not afforded the benefit of the filing date of the provisional patent application. M.P.E.P. § 201.11 explains that there are six conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 119(e). The first requirement is that the “second application must be an application for a patent for an invention which is also disclosed in the first application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the first application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112.” M.P.E.P. § 201.11, citing *Transco Prods., Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 U.S.P.Q.2d 1077 (Fed. Cir. 1994).

In the Final Office Action, the Examiner provides Applicant with a copy of *Baumgarten Provisional*. However, the portions of the published U.S. patent application (“*Baumgarten*”) relied upon by the Examiner do not appear in the provisional application (“*Baumgarten Provisional*”). For instance, in item 53 on page 12 of the Final Office Action, the Examiner asserts “*Baumgarten* does teach all of the above mentioned elements through the disclosure of a automatic testing application that is customized for each specific position (Fig. 2, Para 0031-0032)”. Thus, the Examiner relies upon Fig. 2 and paragraphs 0031-0032 of *Baumgarten*. However, Fig. 2 is not present in *Baumgarten Provisional*. Rather, *Baumgarten Provisional* only includes Fig. 1 therein. Further, paragraphs 0031-0032 of *Baumgarten* are not present in *Baumgarten Provisional*. That is, *Baumgarten Provisional* does not include the subject matter of paragraphs 0031-0032 of *Baumgarten*. Thus, the relied upon portions of *Baumgarten* are not actually prior art under 35 U.S.C. § 102(e) because such relied upon teachings of *Baumgarten* are not actually present in *Baumgarten Provisional* but are instead newly added matter included in the published U.S. patent application (and

therefore should not be afforded the benefit of the provisional application's filing date).

Further, the Examiner asserts in item 53 on page 12 of the Final Office Action "The testing application is automatically generated once a potential candidate chooses a specific job through the Internet listing, the test scores are then collected and ranked for future employer assessment (Fig. 3, Para 0034, Para 0048-0049, Claim 4)". Thus, the Examiner relies upon Fig. 3, paragraphs 0034 and 0048-0049, and claim 4 of *Baumgarten*. However, Fig. 3 is not present in *Baumgarten Provisional*. Rather, *Baumgarten Provisional* only includes Fig. 1 therein. Further, paragraphs 0034 and 0048-0049 of *Baumgarten* are not present in *Baumgarten Provisional*. That is, *Baumgarten Provisional* does not include the subject matter of paragraphs 0034 and 0048-0049 of *Baumgarten*. Further, claim 4 of *Baumgarten* is not present in *Baumgarten Provisional*. Rather, *Baumgarten Provisional* does not include any claims therein. Thus, the relied upon portions of *Baumgarten* are not actually prior art under 35 U.S.C. § 102(e) because such relied upon teachings of *Baumgarten* are not actually present in *Baumgarten Provisional* but are instead newly added matter included in the published U.S. patent application (and therefore should not be afforded the benefit of the provisional application's filing date).

If the Examiner believes that any of the above portions of *Baumgarten* relied upon in maintaining the claim rejections in the Final Office Action are actually present in *Baumgarten Provisional*, Applicant respectfully requests that the Examiner specifically identify the portions of *Baumgarten Provisional* that provides the above teachings. Otherwise, Applicant requests that the rejections be withdrawn, as the relied upon teachings of *Baumgarten* are not proper prior art under 35 U.S.C. § 102(e).

B. *Baumgarten Provisional* Fails to Teach All Elements of the Claims

As discussed in section "A" above, the relied upon portions of *Baumgarten* are not prior art under 35 U.S.C. § 102(e) because such teachings are not present in *Baumgarten Provisional*. Only those portions of *Baumgarten* that are present in *Baumgarten Provisional* are prior art to the present application under 35 U.S.C. § 102(e). Thus, for *Baumgarten* to anticipate the claims of the present application, *Baumgarten Provisional* must anticipate those claims. As discussed further below, *Baumgarten Provisional* fails to anticipate the claims of the present application.

To anticipate a claim under 35 U.S.C. § 102, a single reference must teach every element of the claim, *see M.P.E.P. § 2131*. As discussed further below, *Baumgarten Provisional* does not teach every element of the rejected claims, and therefore fails to anticipate such claims under § 102(e).

For example, independent claim 1 recites, *inter alia*, “based on said desired hiring criteria of said employer, said computer program generating at least one customized application program that is executable to interact with candidates for employment with said employer” (emphasis added).

Independent claim 30 recites, *inter alia*, “a computer program executable by said processor-based device to receive as input desired hiring criteria of said employer and generate at least one application program, said at least one application program executable to interact with candidates” (emphasis added).

Independent claim 54 recites, *inter alia*, “code for presenting a user interface for receiving hiring criteria from an employer; and code for generating at least one qualification program for interacting with candidates” (emphasis added).

Independent claim 62 recites, *inter alia*, a business method comprising “allowing an employer access to a computer executable program, wherein said computer executable program enables said employer to generate at least one customized application program based on a desired hiring criteria of said employer; and allowing candidates access to the at least one generated customized application program” (emphasis added).

Baumgarten Provisional fails to teach or suggest at least the above limitations of independent claims 1, 30, 54, and 62. *Baumgarten Provisional* teaches a system and method that “enables a prospective job candidate to model a personalized career path using a computer network, such as the Internet, based on their backgrounds, current position and their career aspirations.” *See “Summary of the Invention” Section on page 7 of Baumgarten Provisional.* The provisional application further provides that such “a path would be designed using adaptive software which would use a database of career paths to determine the probability of a certain succession of positions and would, based on a series of choices and responses by the job candidate, outline each step of a career path for the candidate.” *See*

“Summary of the Invention” Section on page 7 of *Baumgarten Provisional*. *Baumgarten Provisional* fails to teach a computer program generating at least one customized application program that is executable to interact with candidates for employment with an employer, as recited by independent claim 1, for example. While *Baumgarten Provisional* teaches a software program that receives input from a prospective job candidate and outputs a personalized career path for the candidate, the software program does not generate at least one customized application program that is executable to interact with candidates for employment with an employer.

Baumgarten Provisional describes the following steps at page 8 thereof:

1) Candidate, Employee, or Intermediary (user) fills out a background profile with such characteristics as education, positions held, company descriptors at each position such as company size, location, and industry, and Candidate, Employee, or Intermediary (user) fills out an aspiration profile with such characteristics as desired location, position title, company descriptors such as company size, industry, etc. *See “Step One” on page 8 of Baumgarten Provisional.*

2) Utilizing a means of analysis including but not limited to database search, heuristic analysis, projected mapping, neural net processing, etc., the CACM system identifies possible career paths to fill in the most likely steps between the background profile suggested and the aspiration profile desired. *See “Step Two” on page 8 of Baumgarten Provisional.*

3) User has the opportunity to change aspects of their suggested career path by entering additional information. *See “Step Three” on page 8 of Baumgarten Provisional.*

4) User has the ability to save his/her “career tree” for future review and can also opt-in to content delivered on screen, via e-mail, wireless device or other means. *See “Step Four” on page 8 of Baumgarten Provisional.*

In view of the above, *Baumgarten Provisional* teaches a system in which a user can input a profile of background information and an aspiration profile of a desired position, and the software program identifies possible career paths that the user may follow to achieve the desired position. *Baumgarten Provisional* fails to teach or suggest a computer program generating at least one customized application program that is executable to interact with candidates for employment with an employer, as recited by independent claim 1, for example.

That is, the software program of *Baumgarten Provisional* does not generate at least one customized application program, but instead executes to output a career path for a user.

Thus, *Baumgarten Provisional* fails to teach or suggest at least the above-identified elements of independent claims 1, 30, 54, and 62. As such, neither *Baumgarten Provisional* nor *Baumgarten* anticipates these claims under 35 U.S.C. § 102(e).

C. Relied Upon Teachings of *Baumgarten* Fail to Teach All Claim Elements

As discussed in section “A” above, the relied upon portions of *Baumgarten* are not prior art under 35 U.S.C. § 102(e) because such teachings are not present in *Baumgarten Provisional*. However, even if the teaching of *Baumgarten* relied upon by the Examiner is prior art under 35 U.S.C. § 102(e), without conceding that point, Applicant submits that the claims are not anticipated by *Baumgarten* because *Baumgarten* fails to teach each and every element of the claims. To anticipate a claim under 35 U.S.C. § 102, a single reference must teach every element of the claim, *see M.P.E.P. § 2131*. As discussed further below, *Baumgarten* does not teach every element of the rejected claims, and therefore fails to anticipate such claims under § 102(e).

For example, independent claim 1 recites, *inter alia*, “based on said desired hiring criteria of said employer, said computer program generating at least one customized application program that is executable to interact with candidates for employment with said employer” (emphasis added).

Independent claim 30 recites, *inter alia*, “a computer program executable by said processor-based device to receive as input desired hiring criteria of said employer and generate at least one application program, said at least one application program executable to interact with candidates” (emphasis added).

Independent claim 54 recites, *inter alia*, “code for presenting a user interface for receiving hiring criteria from an employer; and code for generating at least one qualification program for interacting with candidates” (emphasis added).

Independent claim 62 recites, *inter alia*, a business method comprising “allowing an employer access to a computer executable program, wherein said computer executable program enables said employer to generate at least one customized application program based on a desired hiring criteria of said employer; and allowing candidates access to the at least one generated customized application program” (emphasis added).

Baumgarten fails to teach or suggest at least the above limitations of independent claims 1, 30, 54, and 62, as discussed more fully in Applicant’s first Amendment (mailed January 28, 2003). In response to Applicant’s arguments, the Examiner contends in the Final Office Action that *Baumgarten* teaches the above elements “through the disclosure of a automatic testing application that is customized for each specific position.” Item 53 on page 12 of Final Office Action. In maintaining this rejection, the Examiner relies upon Fig. 2 and paragraphs 0031-0032 of *Baumgarten*, which teach:

- 1) First, an employer contacts a recruiting firm with a job position that needs filling. *See* paragraph 31 and step 202 of FIGURE 2 of *Baumgarten*.
- 2) Next, the recruiting firm prepares an examination for potential candidates to identify those candidate not in possession of the required skills and knowledge for the listed position. The recruiting firm, in preparing the exam, relies on their experience and knowledge of filling comparable positions in the past and receives assistance from the employer as well. *See* paragraph 32 and step 204 of *Baumgarten*.

In no way do the above portions of *Baumgarten* teach a computer executable program for generating a customized application program. For instance, the above portion of *Baumgarten* fails to teach a computer program generating at least one customized application program that is executable to interact with candidates for employment with an employer, as recited by independent claim 1, for example. Rather, the above portion of *Baumgarten* teaches that the recruiting firm personnel prepares an examination for potential candidates to identify those candidate not in possession of the required skills and knowledge for the listed position. Thus, *Baumgarten* fails to teach or suggest at least the above-identified elements of independent claims 1, 30, 54, and 62.

In view of the above, *Baumgarten* fails to teach a computer program generating at least one customized application program that is executable to interact with candidates for employment with an employer, as recited by independent claim 1, for example. Rather, *Baumgarten* teaches that the recruiting firm personnel prepares an examination for potential candidates to identify those candidate not in possession of the required skills and knowledge for the listed position. Thus, *Baumgarten* fails to teach or suggest at least the above-identified elements of independent claims 1, 30, 54, and 62.

Further, independent claim 1 recites “responsive to input from each of said candidates to the at least one generated customized application program, said at least one generated customized application program automatically determining whether each of said candidates qualifies for a position of employment with the employer” (emphasis added).

Similarly, independent claim 30 recites “said at least one application program executable to interact with candidates and determine whether each of said candidates qualifies for a position of employment with said employer” (emphasis added).

Independent claim 54 recites “code for generating at least one qualification program for interacting with candidates and determining whether each of said candidates qualifies for a position of employment with said employer” (emphasis added).

Independent claim 62 recites “responsive to input from each of said candidates to the at least one customized application program, said at least one customized application program automatically determining whether each of said candidates qualifies for a position of employment with the employer” (emphasis added).

Baumgarten fails to teach or suggest these further elements of independent claims 1, 30, 54, and 62, as discussed more fully in Applicant’s first Amendment (mailed January 28, 2003). In response to Applicant’s arguments, the Examiner contends in the Final Office Action that *Baumgarten* teaches that the “testing application is automatically generated once a potential candidate chooses a specific job through the Internet listing, the test scores are then collected and ranked for future employer assessment.” Item 53 on page 12 of Final Office Action. In maintaining this rejection, the Examiner relies upon Fig. 3 and paragraphs 0034 and 0048-0049, and claim 4 of *Baumgarten*, which teach:

1) The job description is posted on the web site to be accessible by candidates, or candidates access the web site to search the posted job listings, and a candidate may submit an indication of their interest in a posted position as well as a personal profile, wherein submitting the profile can be a multi-step process in which one of the steps in the completion of the exam prepared by the recruiting firm. *See* paragraphs 33-34 and steps 206 and 208 of *Baumgarten*. By applying for a position, the user is automatically directed to the online exam associated with the desired job position. *See* paragraphs 48-49 of *Baumgarten*.

The relied upon portions of *Baumgarten* do not teach that a testing application is automatically generated once a potential candidate chooses a specific job through the Internet listing, but rather, the testing application is apparently generated by a programmer (e.g., through typical programming) and upon a user applying for a position on the Internet the user is automatically directed to the online exam. That is, the online exam to which the user is directed is not taught as being automatically generated by the system of *Baumgarten*.

Baumgarten teaches that from the submitted profiles and exams, the recruiting firm can select candidates that appear to be well matched to the position. *See* paragraph 35 and step 210 of *Baumgarten*. *Baumgarten* fails to teach or suggest a “generated customized application program automatically determining whether each of said candidates qualifies for a position of employment with the employer”, as recited by claim 1, for example. Rather, *Baumgarten* teaches that the recruiting firm personnel determines those candidates in possession of the required skills and knowledge for a listed position, as opposed to a customized application program (or “qualification program”) making such determination. Thus, *Baumgarten* fails to teach or suggest at least the above-identified elements of independent claims 1, 30, 54, and 62.

In view of the above, Applicant submits that *Baumgarten* fails to teach or suggest each and every element of independent claims 1, 30, 54, and 62, and therefore such independent claims are not anticipated under 35 U.S.C. § 102(e) by *Baumgarten*.

Further, dependent claims 2-10, 12-19, 22-29, 31-38, 40-53, 55-59, 61, 63-69, and 72-77 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Baumgarten*. In view of the above, Applicant respectfully submits that independent claims 1, 30, 54, and 62 are not anticipated under 35 U.S.C. § 102(e) by *Baumgarten* because *Baumgarten* fails to teach each

and every element of such independent claims. Further, each of dependent claims 2-10, 12-19, 22-29, 31-38, 40-53, 55-59, 61, 63-69, and 72-77 depend either directly or indirectly from one of independent claims 1, 30, 54 and 62, and thus inherit all limitations of the respective independent claims from which they depend. It is respectfully submitted that dependent claims 2-10, 12-19, 22-29, 31-38, 40-53, 55-59, 61, 63-69, and 72-77 are allowable not only because of their dependency from their respective independent claims for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of the respective base claim from which they depend).

III. Claim Rejections Under 35 U.S.C. § 103(a) over *Baumgarten* in view of *Nadkarni*

Dependent claims 11, 20, 39, 60, and 70 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Baumgarten* in view of *Nadkarni*. As discussed above, Applicant respectfully submits that independent claims 1, 30, 54, and 62 are of patentable merit over *Baumgarten*. Further, each of dependent claims 11, 20, 39, 60, and 70 depend either directly or indirectly from one of independent claims 1, 30, 54, and 62, and thus inherit all limitations of the respective independent claims from which they depend. It is respectfully submitted that dependent claims 11, 20, 39, 60, and 70 are allowable not only because of their dependency from their respective independent claims for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of the respective base claim from which they depend).

IV. Conclusion

Claims 1-77 remain pending in the current application. As shown above, there are important differences between the claims and the applied art. Moreover, a person of ordinary skill in the art considering the applied art would not find these differences obvious. Accordingly, Applicant respectfully asserts that claims 1-77 are allowable over the applied art. Therefore, Applicant respectfully requests that these claims be passed to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 59428/P001US/10020580 from which the undersigned is authorized to draw.

Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Dated: May 20, 2003

Respectfully submitted,

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